

REMARKS

Claims 1-6 and 10-14 were examined by the Office, and all claims were rejected in the final Office Action of June 17, 2009. With this response, no claims are amended, added or cancelled. Applicant respectfully requests reconsideration and withdrawal of the rejections in view of the following discussion.

Specification

Applicant has amended the application by way of preliminary amendment submitted July 16, 2004 to include the Cross-Reference to Related Applications in the specification. Therefore, applicant respectfully requests that the objection to the specification be withdrawn.

Claim Rejections under 35 USC 103

In section 4, on page 3 of the Office Action, claims 1-6 and 10-14 are rejected under 35 U.S.C. § 103(a) as unpatentable over Miyashita (U.S. Patent No. 6,909,906) in view of Steele (U.S. Patent No. 6,201,534), and in further view of Lee (U.S. Appl. Publ. No. 2003/0016417). Applicant respectfully submits that claim 1 is not disclosed or suggested by the cited references, alone or in combination, because the cited references fail to disclose or suggest all of the limitations recited in claim 1. The cited references at least fail to disclose or suggest that the pointing device is configured to operate independent of a functionality of the existing electronic device, as recited in claim 1. Therefore, for at least this reason, claim 1 is not disclosed or suggested by the cited references.

According to claim 1, an already existing electronic device has in addition to its main function an auxiliary function of a pointing device. The pointing device is defined to be a device that communications with an external electronic screen device, as discussed for example on page 1, lines 20-22 of the specification. Applicant respectfully submits that this limitation of claim 1 is not disclosed or suggested by the cited references for at least the following reasons.

It would not have been obvious to one of ordinary skill in the art to achieve as a result the solution disclosed by claim 1 by adding the remote control system (400a) of Steele to the telephone main body of Miyashita. Such a device could not be for multiple usage as a telephone and cursor pointing device for the following reasons. In an embodiment of Steele there is described the remote control system (400a) that includes the remote control terminal (414a) which communicates with the video monitor (416a) via the signal generator (406a) and the lens (409a) in the remote control terminal (414a). See Steele column 6, lines 40-56. The main functionality of the remote control system (400a) is that the remote control terminal (414a) cooperates with the video monitor (416a) as a pointing device. If the remote control system (400a) of Steele were added to the telephone set main body (102) of Miyashita, the main function of the already existing device is to act as the pointing device. This is because the already existing device is not able to act as a mobile telephone, since the functionality of the portable telephone (100) of Miyashita requires integration of the operation unit (105) so that the keypad (112) of the operation unit (105) is connected with the electrodes (127). See Miyashita column 5, lines 23-32; column 6, lines 5-8. Steele does not disclose such a keypad, since it discloses the keypad (106a) of the remote control terminal (414a) having remote control functionality. Therefore, by adding the remote control system (400a) of Steele to the telephone set main body (102) of Miyashita one of skill in the art cannot arrive at the auxiliary function as a pointing device, as recited in claim 1.

In addition, it would not be obvious for one of skill in the art to combine the device of Lee with the devices of Miyashita and Steele to arrive at the limitations recited in claim 1. Lee teaches a pointing device that can act as a laser pointer or a generic optical mouse. The main functionality of the device of Lee is to be the pointing device. The already existing device of Lee is the pointing device, and therefore it is not an auxiliary function as the pointing device is in claim 1. Even if one of skill in the art combines the teachings of Miyashita, Steele and Lee the limitations recited in claim 1 would not be the result.

Instead, Lee teaches away from the idea of the invention, since according to the invention performing the auxiliary function does not exclude the simultaneous operation of the main function, i.e. the mobile telephone may ring (and be answered) while using it as

the pointing device. The phrase “configured to operate independent of a functionality of the existing electronic device” of claim 1 defines this feature. In contrast, Lee teaches switching between operation modes and operation of each mode separately, i.e. by selecting a first mode for operation of the first mode, and a second mode for operation of the second mode. See Lee paragraphs [0030]-[0031]. Therefore, Lee only discloses operation of the different modes one at a time, and not simultaneous as recited in claim 1. For at least the reasons discussed above, claim 1 is not disclosed or suggested by the cited references.

The claims rejected above, and depending from claim 1 are not disclosed or suggested by the cited references at least in view of their dependencies.

Conclusion

For all the foregoing reasons, it is believed that all of the claims of the application are now in condition for allowance and their passage to issue is earnestly solicited. The undersigned hereby authorizes the Commissioner to charge Deposit Account No. 23-0442 for any fee deficiency required to submit this response.

Respectfully submitted,

Date: 13 August 2009

s/Keith R. Obert/
Keith R. Obert
Attorney for Applicant
Registration No. 58,051

WARE, FRESSOLA, VAN DER SLUYS
& ADOLPHSON LLP
755 Main Street, P.O. Box 224
Monroe, Connecticut 06468
Telephone: (203) 261-1234
Facsimile: (203) 261-5676